

REMARKS

The Applicants have thoroughly considered the Official Action dated March 31, 2005 and have prepared this Amendment in response thereto. The Applicants have concurrently filed a Request for Continued Examination, a Petition for Three-Month Extension of Time, and the required filing fees. In addition, the Applicants have submitted the “Declaration Under 37 CFR§1.131 of Robert Andrew Byers, Jr.” and the “Declaration Under 37 CFR§1.132 of Kenneth R. Taylor” in support of its arguments.

Summary of Amendments

The Applicants have amended claims 1 to change the transition phrase back to “comprising”, as originally presented.

Claim 8 was amended to correct its dependency in response to the Examiner’s objection.

Claim 9 was amended in response to the examiner’s rejection under 35 USC §101 to further clarify what is being performed by the computer.

Claims 21 and 35 were amended to replace the phrase “purchase history” with “order entry” in order to correct a typographical error that resulted in a lack of antecedent basis.

Claims 1, 2, 5, 8-9, 15-16, 18-19, 21-30, 32-33 and 35-42 remain in the application. For the reasons set forth below, the Applicants believe that the above amendments fully address and overcome the rejections. Therefore, the Applicants respectfully request that the Examiner reconsider these rejections in light of the amendments and the remarks below and allow all pending claims.

The following remarks will follow the order set forth in the Official Action:

Claim Objections

Claim 8 was objected to because it depended from cancelled claim 6. In response, the

Applicants have amended claim 8 to depend from claim 1, as assumed by the Examiner. As this amendment fully addresses this objection, the Applicants request that this objection be withdrawn.

Rejections Under 35 USC §101

Claim 9 was rejected under 35 USC §101 based upon the assertion that the method claims do not claim a technological basis in the body of the claim. In response, the Applicants have amended claim 9 in accordance with the Examiner's recommendations to further clarify what steps the computer is performing. In particular, the Applicants have clarified that the signal is received "*via said network*" and that the form is transmitted to the "*buyer computer via said network*". The Applicants believe that claim 9, as amended, provides an adequate technological basis and requests that the Examiner reconsider and withdraw this rejection in light of the Applicants' amendment.

Rejections Under 35 USC §112, first paragraph

Claims 1, 2, 5, 8 and 9 were rejected under 35 U.S.C. §112, first paragraph, based upon the assertion such claims fail to meet the enablement requirement. In particular, it was asserted that "(t)he interaction with the seller computer, such as processing and transmitting the order information to the seller so that the order is delivered or shipped to the buyer is critical or essential to the practice of ht invention, but not included in the claims". The Examiner points to the amendment of claim 1 to include the closed ended transition "consisting of" as eliminating such interaction.

The Applicants respectfully disagree with this rejection for the reasons set forth in paragraph 4 of the attached Declaration Under 37 CFR §1.132 of Kenneth R. Taylor. Notwithstanding the Applicants' disagreement with this rejection, the Applicants have

determined that the closed ended transition “consisting of” is unnecessary given the cited art and, consequently, has amended claim 1 to revert back to the original open ended transition “comprising”. As the amendment to the closed ended “consisting of” transition was the stated reason for the enablement rejection, the Applicants assert that the amendment fully addresses and overcomes this rejection. Accordingly, the Applicant respectfully request that the rejections under 35 U.S.C. §112, first paragraph, be reconsidered in light of this amendment and withdrawn

Rejections Under 35 USC §112, second paragraph

Claims 1, 2, 5, 8 and 9 were rejected under 35 U.S.C. §112, second paragraph, based upon the assertion such claims are indefinite due to the addition of limitations to a claim using the closed ended transition “consisting of”. As none of these claims adds method steps, but rather seeks to further limit previously claimed steps, the Applicants respectfully disagree with this rejection. However, as noted above, the Applicants have determined that the closed ended transition “consisting of” is unnecessary given the cited art and, consequently, has amended claim 1 to revert back to the original open ended transition “comprising”. As the amendment to the closed ended “consisting of” transition was the stated reason for the indefiniteness rejection, the Applicants assert that the amendment fully addresses and overcomes this rejection. Accordingly, the Applicant respectfully request that the rejections under 35 U.S.C. §112, second paragraph, be reconsidered in light of this amendment and withdrawn.

Rejections Under 35 USC §103(a)

Claims 1, 2, 5, 8, 9, 15, 16, 18, 19, 21-30, 32, 33 and 35-42 were rejected under 35 U.S.C. §103(a) as being obvious based upon the previously cited Barnes reference in

combination with the newly cited Willner reference. In particular, it was asserted that Barnes discloses all claimed limitations except for the a the user specific order entry form in which only entry of data by the user into the quantity field is required to purchase the at least one product, that Willner discloses this feature, and that it would be obvious to modify Barnes to include the feature allegedly disclosed in Willner. For the following reasons, the Applicants respectfully disagree with this rejection.

First, the Applicant asserts that the Willner reference is not prior art. The Willner reference is a non-provisional patent application that was published on May 30, 2002, and claims the benefit of priority of a provisional patent application filed on May 23, 2000. The present patent application was an original application filed on June 27, 2001. Accordingly, the Willner reference may only prior art if it were known or used by others in this country before the invention thereof by the applicant, as set forth in 35 USC §102(a). The only basis for determining that this condition existed is the date of filing of the provisional patent application by Willner, which is prior to the filing of the present application. Therefore, the Willner reference may only be prior art if the subject matter claimed in the present application were not invented prior to May 23, 2000, which is the filing date of the Willner provisional application.

The Applicants assert that the invention claimed in the present application was invented prior to May 23, 2000, and, consequently, that the Willner reference cannot be used as prior art in the rejections under 35 USC §103. In support of this assertion, the Applicants have submitted the attached "Declaration Under 37 CFR§1.131 of Robert Andrew Byers, Jr." (hereafter the Byers Declaration). Mr. Byers is an inventor of the subject matter claimed in all pending claims and declares "that the invention claimed in all claims of the above

referenced patent application was conceived of and reduced to practice at least as early as March 7, 2000.” In support of this declaration, Mr. Byers refers to documentation showing prior development of a computer program product and system having all claimed features. In particular, in paragraph 5 of the Byers Declaration, Mr. Byers “declares that the computer program product and system embodied in the website that generated the order attached as Exhibit B, included all of the subject matter claimed in the above referenced patent application, and that this website was completed at least as early as March 7, 2000.” The Applicants assert that the Byers Declaration is sufficient to “swear behind” the Willner reference and to eliminate it from consideration as prior art in this application.

As the Willner reference is not prior art, the Examiner has admitted that Barnes fails to disclose or suggest a user specific order entry form in which the quantity field is the only field in which a user must enter data, and this limitation is found in all independent claims, the Applicants assert that the requirements of 35 USC §103 have not been met. Therefore, the Applicants respectfully request that the Examiner reconsider and withdraw these rejections in light of the appended Declaration.

Notwithstanding the Applicants’ assertion that the Willner reference is not prior art, the Applicants further assert that the pending claims are unobvious even if the Willner reference were prior art.

As noted in the Applicants’ first Amendment, filed on January 10, 2005, MPEP § 2142 states that “(t)o establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation

of success. Finally, the prior art references must teach or suggest all of the claim limitations.” The Applicants assert that none of these obviousness requirements are met by the cited references.

First, as argued in the Applicants’ Amendment of January 10, 2005, the Applicants assert that the Barnes reference does not disclose or suggest a user specific purchase history form comprising all products that were purchased during a specified time period, as claimed in each of the Applicants’ claims. The Applicants incorporate by reference their prior arguments regarding this issue, as set forth on pages 14 – 16 of the Applicants’ January 10th Amendment, and point to paragraph 5 of the Declaration Under 37 CFR§1.132 of Kenneth R. Taylor (hereafter the “Taylor Declaration”) in support thereof.

Mr. Taylor is one of at least ordinary skill in the relevant arts and declares that “the Barnes reference does not disclose or suggest a user specific purchase history form comprising all products that were purchased during a specified time period” In support of this declaration, Mr. Taylor further declares “a repeat of an old requisition request, which was asserted by the examiner to read on this limitation, does not provide the buyer with a list of all products purchased during a specified time period, nor does it provide the same advantages as the claimed user specific purchase history form This declaration is based upon the fact that each old requisition request would include only those items purchased on that particular requisition request, which would require the buyer to search for and add products that were not included on the old requisition request, and would not allow the buyer to differentiate between similar products when placing their order. Conversely, the user specific purchase history form described and claimed by the applicant includes all products purchased within the time period, which allows the buyer to place an order for any combination of previously

ordered products and to easily recognize that similar products have been ordered in the past and to differentiate between the similar products when placing their order.”

Based upon the foregoing, the Applicants respectfully disagree with the Examiner’s assertion that the “Repeat from an old requisition request 33, Figure 11” of the Barnes reference reads on the claimed user specific purchase history form comprising all products that were purchased during a specific time period. Accordingly, the Applicants assert that independent claims 1, 15 and 29 are unobvious because all claimed limitations are neither disclosed nor suggested by the cited art and requests that these rejections be reconsidered and withdrawn.

Second, Applicants likewise assert that independent claims 1, 15 and 29 are unobvious because there is no suggestion or motivation, either in the references themselves or in the knowledge of those in the art, to modify the system of the Barnes reference to include the claimed user specific purchase history form of the Applicant’s invention.

As noted in the January 10th Amendment, Barnes discloses an “Electronic Commerce (EC) system” that “is intended to reduce costs by allowing authorized end users to directly interact with suppliers, rather than through centralized purchasing agents”. “(T)he EC System, designated by the reference numeral 10, is primarily intended to meet the purchasing requirements of a large numbers of employees/users at a buyer, purchaser or customer organization 12 who have recurrent needs to order goods and/or services. Preferably, such goods or services are standard, “non-custom” or “non-production” goods/services that might be found in and ordered from a catalog of a supplier or seller 16, such as office supplies, replacement parts and desktop computer hardware.” *Barnes, column 6, lines 6 – 22*. Using the EC system of Barnes, a buyer may view certain portions of the supplier’s catalog based

upon user settings managed by the buyer organization, and create new purchase requisitions based upon this catalog, repeat prior transactions, or create order templates. However, the Barnes reference fails to address the principal problems that are solved by the Applicants' claimed invention; i.e. the risk of error by insertion of incorrect part numbers and pricing on order forms and the reduction of time taken to place orders. Consequently, the Applicants assert that Barnes provides no motivation to modify the system to include the claimed user specific purchase history form, and that there would be no motivation to combine Barnes with Willner to obtain the Applicants' claimed invention.

The Taylor Declaration supports the Applicants' assertion. In particular, in paragraph 6 of the Taylor Declaration, Mr. Taylor declares that he "would not be motivated to modify the Barnes reference to include the user specific purchase history form claimed by the applicant. This declaration is based partly upon the fact that the system disclosed in the Barnes reference allows a buyer to view only certain portions of the suppliers catalog based upon user settings managed by the by organization. Therefore, because buyers may not order all products previously purchased by the buyer's organization, there would be no need to modify the Barnes reference to include the user specific purchase history form claimed by the applicant. This declaration is also based upon the fact that the system disclosed in the Barnes reference does not allow users to place orders directly from prior requisitions."

The lack of motivation to combine Barnes with Willner is also supported by paragraph 7 of the Taylor Declaration, in which Mr. Taylor declares that "I would not be motivated to combine the Barnes and Willner references cited by the Examiner to obtain a system including a user specific order entry form where a quantity entry field is the only fields in which entry of data by the user is required to purchase a product. I further declare that such a

combination would not result in a method system or computer product that provides the advantages of the applicant's invention. These declarations are based upon the fact that Barnes fails to address the principal problem that is solved by the Applicants' claimed invention; i.e. the risk of error by insertion of incorrect part numbers and pricing on order forms. Barnes allows products to be ordered in two distinct ways; by allowing the user to browse through portions of the suppliers catalog to choose the desired products and add them to a requisition, in a manner similar to they would were they to browse through a catalog, and by allowing the user to effectively repeat transactions that have been previously set-up, as in cases where user generated templates are used or where prior requisitions of particular products are copied. I declare that each of these ways of placing an order is time consuming and has a significant risk of error. Where a new requisition is made, or a template set up, the user must sort through entire portions of the supplier's catalog in order to find the product or products that they need. In cases where similar products are found in the catalog and the user is unsure of which to choose, the user must go back to run reports on previously ordered products, find the correct product, go back to the order form, and enter the correct product in the form. I declare that this problem is not eliminated in cases where templates are used or prior requisitions are repeated, as the user must find the correct prior requisition or template on the system, which can be time consuming and prone to error. Further, the user cannot add products directly to this requisition or template. Instead, the user is forced to create a new requisition or template in order to accomplish this task. I declare that each of these means for ordering products using the Barnes system is time consuming and prone to error. Accordingly, there is nothing in the Barnes disclosure that would suggest that it be modified to include the user specific purchase history form claimed by the applicants."

The Applicants also assert that the Willner reference fails to provide such motivation. The Taylor Declaration also supports this assertion. In particular, in paragraph 8 of the Taylor Declaration, Mr. Taylor declares that “the Willner reference teaches away from the use of the claimed user specific order entry form because it discloses a purchasing system for internal use by a buyer organization in order to simplify the internal requisition process and not a system for use by a buyer and a seller. The Willner reference requires the user to select products from a database of vendor catalogs managed by the buyer’s organization and does not provide any means for the user to view prior purchases. I declare that, were such a feature included or suggested, that there would be no need for the “compatibility check” performed by the Willner system.”

Finally, the Applicant asserts that the importance of such a feature, coupled with the fact that it has not heretofore been utilized in the art, is strong evidence of the failure of others to identify the problem solved by the Applicants’ invention. The Taylor Declaration again supports this assertion. In particular, in paragraph 9 of the Taylor Declaration, Mr. Taylor declares that “a method for receiving an order, a computer program product, and a system that include the claimed user specific purchase history form in which a quantity entry field is the only field in which a user is required to enter data provides distinct advantages over current systems and, consequently, it is my belief that the applicants have identified and solved a problem that has heretofore gone unrecognized. It is likewise my belief that such a system would be in widespread use by this time if the problem solved thereby were recognized. Accordingly, I further declare that a method for receiving an order, a computer program product, and a system that include the claimed user specific purchase history form, are not

obvious, either in light of the Barnes and Willner references cited by the Examiner for based upon the knowledge of those of at least ordinary skill in the art.”

For the reasons set forth above, it is asserted that independent claims 1, 15 and 29 are unobvious. Further, insofar as dependent claims 2, 5, 9, 16–19, 23–28, 30–33 and 37–42, depend from unobvious claims, the Applicants assert that these claims are likewise unobvious and have elected not to provide additional remarks concerning the patentability of these claims. Accordingly, the Applicants respectfully request that the Examiner reconsider these rejections in light of the amendments and the remarks herein and allow all pending claims.

Conclusion

It is felt that a full and complete response has been made to the Official Action and, as such, places the application in condition for allowance. Such allowance is hereby respectfully requested. If the Examiner feels, for any reason, that a personal interview will expedite the prosecution of this application, the Examiner is invited to phone the Applicants’ attorney at the number set forth below.

Respectfully submitted,



Date September 30, 2005

Michael J. Persson
Attorney for Applicant
Registration No. 41,248
Lawson & Persson, P.C.
67 Water Street, Suite 103
Laconia, NH 03246
Phone: 603-528-0023
Fax: 603-528-3332